

Mailed: 11/06/02

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Human Rights Campaign Foundation

Serial No. 76/114,506

Geri L. Haight for Human Rights Campaign Foundation.

Kevin M. Dinallo, Trademark Examining Attorney, Law Office
110 (Chris A. F. Pedersen, Managing Attorney).

Before Seeherman, Hanak and Hohein, Administrative
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Human Rights Campaign Foundation (applicant) seeks to register in typed drawing form HRC WORKNET for "providing employment information regarding policies and practices concerning issues specific to gay, lesbian, bisexual, and transgendered employees via an on-line global computer network." The application was filed on August 22, 2000 with a claimed first use date of September 1999.

Citing Section 2(d) of the Trademark Act, the Examining Attorney refused registration on the basis that applicant's mark, as applied to applicant's service, is likely to cause confusion with the mark HRC previously

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registered in typed drawing form for "human resources consulting services, namely, assisting businesses in assessment and planning in the fields of personnel and human resource management." Registration No. 1,425,066.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the goods or services and the similarities of the marks. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.").

Considering first the marks, one point should be clarified at the outset. In the first Office Action, the Examining Attorney stated that "the applicant must insert a disclaimer of WORKNET in the application because it is descriptive of the services the applicant is offering." In response, applicant submitted the disclaimer in the form suggested by the Examining Attorney.

However, at no time has the Examining Attorney submitted any evidence whatsoever demonstrating that the term WORKNET is descriptive of applicant's services. In the first Office Action, the Examining Attorney merely asserted that "WORKNET is a commonly used term in the area of the applicant's services, specifically, information regarding work or employment related issues offered over the global computer network."

We have serious doubts as to whether WORKNET is indeed merely descriptive of applicant's services. In this regard, this Board has consulted over fifteen specialized computer reference works, and not one of the fifteen list "worknet" or "work net." Some of the more comprehensive reference works consulted by this Board include Microsoft Computer Dictionary (5th ed. 2002), McGraw-Hill Computer Desktop Encyclopedia (9th ed. 2001), Dictionary of Networking (3rd ed. 1999) and The Computer Glossary (8th ed. 1998). Moreover, we note that initially the Examining Attorney cited a second registration as a bar to the application. This registration is for the mark WORKNETT for "reviewing standard and practices to assure compliance with employment laws and regulations, namely, providing employee training on sexual harassment issues via a global computer network." (emphasis added). Registration No.

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2,374,399. This registration issued without resort to a claim of acquired distinctiveness pursuant to Section 2(f) of the Trademark Act. If WORKNET were truly merely descriptive of providing employment information over a global computer network, then it is hard to explain how the registration for WORKNETT issued. It is fundamental that a slight misspelling of a merely descriptive word would not turn that word into a trademark. 1 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 11:31 at page 11-52 (4th ed. 2001). Obviously, the registered mark WORKNETT represents an extremely slight misspelling of the word "worknet," which the Examining Attorney contends is merely descriptive of providing employment information via a global computer network.

Nevertheless, having said the foregoing, we are constrained in our likelihood of confusion analysis to consider the WORKNET portion of applicant's mark to be merely descriptive because applicant agreed to the disclaimer required by the Examining Attorney without arguing in the alternative that the WORKNET portion of its mark was not merely descriptive of its services. However, even if the WORKNET portion of applicant's mark is merely descriptive of its services, it cannot be ignored in our likelihood of confusion analysis. This is because "the

basic principle in determining confusion between marks is that marks must be compared in their entirety and must be considered in connection with the particular goods or services for which they are used." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 750 (Fed. Cir. 1985)(emphasis added). Indeed, the Court in National Data went so far as to state that "the technicality of a disclaimer in [applicant's] application to register its mark has no legal effect on the issue of likelihood of confusion. The public is unaware of what words have been disclaimed during prosecution of the trademark application at the PTO." National Data, 224 USPQ at 751.

Marks are compared in terms of visual appearance, pronunciation and connotation. Obviously, WORKNET is the largest portion of applicant's mark. Its presence in applicant's mark causes the mark in its entirety (HRC WORKNET) to be dissimilar from the registered mark HRC in terms of visual appearance and pronunciation. Moreover, to the extent that WORKNET has a meaning, as contended by the Examining Attorney, then the presence of this word in applicant's mark causes the two marks to be at least somewhat dissimilar in terms of meaning. Finally, there is no dispute that the initialism HR stands for "human resources." Acronyms, Initialisms & Abbreviations

Dictionary (29th ed 2001). Registrant's services are a particular form of human resources consulting services, and applicant's services of providing employment information are at least tangentially related to human resources. Thus, two of the three letters which are common to both registrant's mark and applicant's mark are highly descriptive (if not generic) for registrant's services, and are at least highly suggestive of applicant's services. In making this determination with regard to registrant's mark HRC, it should be made clear that we are not impermissively attacking the registration. As our primary reviewing Court has made clear, "a showing of descriptiveness or genericness of a part of a mark does not constitute an attack on the registration." National Data, 224 USPQ at 752.

In sum, we find that the marks are different in terms of visual appearance and pronunciation. In terms of connotation, the presence of the word WORKNET in applicant's mark causes it to be dissimilar from the registered mark. Moreover, the component common to both marks (HRC) begins with the initialism HR which is highly descriptive if not generic for registrant's services, and is at least highly suggestive of applicant's services.

Turning to a consideration of the respective services of applicant and registrant, we note at the outset that registrant's identification of services contains the limitation "assisting businesses." Thus, registrant's services are not directed to individuals. The only common purchasers or users of both registrant's human resources consulting services and applicant's employment information services relating to issues specific to a certain class of individuals are businesses, and not individuals. At page 11 of his brief, the Examining Attorney acknowledges that individuals within businesses who are responsible for purchasing human resources consulting services are sophisticated. Our primary reviewing Court has made it clear that purchaser "sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care." Electronic Design & Sales v. Electronic Data Systems, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992). Moreover, these sophisticated individuals when selecting human resources consulting services would obviously engage in significant discussions with registrant and would exercise a fair degree of care prior to signing a contract for providing human resources consulting services. Thus, not only are the common purchasers of both registrant's and applicant's services

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sophisticated, but in addition, before purchasing registrant's services, the common purchasers would exercise considerable degree of care. As has been noted, there is always less likelihood of confusion when the goods or services "are purchased after careful consideration."

Electronic Design & Sales, 21 USPQ2d at 1392.

In summary, given the dissimilarities in the marks in terms of visual appearance, pronunciation and connotation and the additional fact that the common purchasers of applicant's and registrant's services are sophisticated, we find that there exists no likelihood of confusion.

Decision: The refusal to register is reversed.

Hohein, Administrative Trademark Judge, concurring:

I concur with the conclusion that contemporaneous use of the mark HRC WORKNET for "providing employment information regarding policies and practices concerning issues specific to gay, lesbian, bisexual, and transgendered employees via an on-line global computer network" is not likely to cause confusion with the mark HRC for "human resources consulting services, namely, assisting businesses in assessment and planning in the fields of personnel and human resource management." However, whether applicant's disclaimer of the term WORKNET constitutes an admission of the mere descriptiveness thereof when used in connection with applicant's services would seem to be problematic. While, at one time, it was well settled that a disclaimer of a term in an application constituted both an admission of the merely descriptive nature thereof with respect to the goods or services for which registration is sought and an acknowledgment of the lack of an exclusive right therein at the time of the disclaimer, see, e.g., *Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972) and *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1549 n. 10 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir.

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1991), whether such treatment of a disclaimer is reflective of the current practice of the United States Patent and Trademark Office ("Office") seems questionable.

Specifically, in light of the decision in *In re MCI Communications Corp.*, 21 USPQ2d 1534, 1538-39 (Comm'r Pats. 1991), it was held that Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), permits an applicant to disclaim matter voluntarily, irrespective of whether the matter disclaimed is registrable or unregistrable. All previous Patent and Trademark Office authority holding otherwise was expressly overruled. Thus, while previous practice had prohibited the entry of disclaimers of registrable components of marks, if an applicant presently offers a disclaimer of any matter in a mark, the Office will accept the disclaimer, provided that the entire mark is not disclaimed. The *MCI* decision nevertheless states emphatically that the entry of such a disclaimer does *not* render registrable a mark that is otherwise unregistrable under relevant sections of the Trademark Act, such as Section 2(d), and that the entire mark, including any disclaimed matter, must be evaluated to determine registrability. See TMEP §1213.01(c).

Nonetheless, even if applicant's disclaimer of the term WORKNET is properly regarded as an admission of mere descriptiveness and/or at least an acknowledgement that it

lacks exclusive rights therein, the problem in this case remains the question of precisely what aspect of applicant's services such term merely describes. Here, the Examining Attorney required that "the applicant ... insert a disclaimer of WORKNET ... because it is descriptive of the services the applicant is offering." Applicant, in response, submitted a disclaimer of WORKNET, although it appears to have mischaracterized the requirement, stating that: "The Examining Attorney has requested that the Applicant disclaim the *generic wording* 'WORKNET' apart from the mark as shown" (*emphasis added*). Accordingly, while both the Examining Attorney and applicant seem to be in agreement that such term has a descriptive significance of some sort, neither has provided any indication as to what that significance is and it is simply not clear from the record herein what attributes of applicant's services the term WORKNET merely describes.

Moreover, as to taking judicial notice of "over fifteen specialized computer reference works" concerning the terms "worknet" and "work net," it is of course well established that the fact that a term is not found in a dictionary (or other standard reference works) is not controlling on the question of its registrability, including the issue of mere descriptiveness. See, e.g., In

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re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987) and In re Orleans Wines, Ltd., 196 USPQ 516, 517 (TTAB 1977). Consequently, while it is the case that even if applicant is the first and/or only user of the term WORKNET, that fact does not mean that such term cannot be merely descriptive of its services, see, e.g., In re National Shooting Sports Foundation, Inc., 219 USPQ 1018, 1020 (TTAB 1983) and In re Mark A. Gould, M.D., 173 USPQ 243, 245 (TTAB 1972), the absence thereof from specialized computer reference works would seem to me to indicate that such term is of relatively recent derivation and is confined to applicant's limited field.

Therefore, even assuming that the term WORKNET is merely descriptive of applicant's services, when the respective marks are considered in their entireties, the presence thereof in applicant's HRC WORKNET mark creates enough differences in appearance, pronunciation and connotation from registrant's HRC mark that, in light of the fact that the services at issue are specifically different and are purchased by sophisticated business consumers, a likelihood of confusion does not exist. Cf. In re Hearst Corp., 982 F.2d 493, 25 USPQ2d 1238, 1239 (Fed. Cir. 1992).

Seeherman, Administrative Trademark Judge, dissenting:

I respectfully dissent from the conclusion that there is no likelihood of confusion between HRC WORKNET for "providing employment information regarding policies and practices concerning issues specific to gay, lesbian, bisexual, and transgendered employees via an on-line global computer network" and HRC for "human resources consulting services, namely, assisting businesses in assessment and planning in the fields of personnel and human resource management."

First, because the majority has gone to some effort to address this point, I think it important to reiterate that the term WORKNET in applicant's mark is merely descriptive. The Examining Attorney required a disclaimer of the term "because it is descriptive of the services the applicant is offering" and applicant complied without any discussion, thus clearly conceding the descriptive nature of the term. In fact, although the Examining Attorney stated that WORKNET was descriptive, in its response applicant characterized the term as generic ("The Examining Attorney has requested that the Applicant disclaim the generic wording 'WORKNET' apart from the mark as shown"). The majority points out that the Examining Attorney did not submit any evidence as to the descriptiveness of WORKNET,

but such evidence was clearly not required in view of applicant's acknowledgment of descriptiveness by its immediate offering of the disclaimer. For the Examining Attorney to submit evidence of descriptiveness after the submission of the disclaimer would have been a waste of the Office's resources, and would have burdened the file with unnecessary material. Indeed, in other circumstances we might well have criticized an Examining Attorney for submitting evidence which was so patently unnecessary.

I would add that I cannot remember a panel of this Board ever going to such effort to cast doubt on whether a term is merely descriptive when the applicant and Examining Attorney were in agreement that it is. If the Examining Attorney knew that the majority would consult 15 computer reference works for a listing of "worknet" or "work net," and that the Examining Attorney's conclusion of descriptiveness would be held to such scrutiny, the Examining Attorney might well have submitted evidence that would have satisfied the majority on this score. But as I noted previously, such evidence was not necessary in view of the applicant's clear concession that WORKNET is merely descriptive.

Returning to the issue of likelihood of confusion, I believe that the marks are extremely similar. I agree with

the majority's point that the term WORKNET in applicant's mark, despite the fact that it has been disclaimed, must be considered in the determination of likelihood of confusion. However, it is well established that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. **In re In re National Data Corp.**, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Typically disclaimed words are given less weight, and I believe that should be the case here. Consumers will look to the HRC portion of applicant's mark for its source-identifying significance, and regard the term WORKNET as a description of the service. (Even if the term WORKNET were to be considered suggestive, rather than merely descriptive, I believe that HRC would still carry a stronger source-identifying significance, being in the nature of a house mark with WORKNET being viewed as a "product mark" for the service of providing employment information.)

Thus, although applicant's mark contains the additional term WORKNET, I do not believe that this term distinguishes the marks. Rather, consumers who are familiar with the registrant's HRC human resources

consulting services are likely to regard HRC WORKNET, used in connection with providing employment information via a global computer network, as a variation of the HRC mark which has been adopted for the services rendered via the network.

The majority also notes that HR stands for "human resources," a point with which I agree. However, the majority then goes on to say that two of the three letters which are common to both marks are highly descriptive for the registrant's services and at least highly suggestive of applicant's services. I view this statement as an implication that consumers will not accord this similarity much weight in their view of the marks as a whole.

However, the letters HR in both marks are not visually separate, but are part of HRC. Thus, I do not think that, as used in the marks, consumers are likely to discount the HR portion of the marks. More importantly, the similarity between the marks is not just in the initialism HR, but it is in the identical element HRC, which is the entirety of the registered mark and the first "word" of applicant's mark.

As for the services, the majority does not dispute that they are related,¹ and that the classes of consumers are identical in part. The majority points out that the common class of purchasers are businesses, and that such consumers are sophisticated. I do not disagree with either of these assertions. However, I disagree with the majority's conclusion that the sophistication of these consumers would avoid confusion. Because of the similarity of the trademarks, and the fact that the additional term WORKNET does not distinguish applicant's mark, as previously discussed, even sophisticated consumers are likely to be confused.

The majority suggests that "these sophisticated individuals when selecting human resources consulting services would obviously engage in significant discussions with registrant and would exercise a fair degree of care prior to signing a contract for providing human resources consulting services." I have several problems with this assertion. First, a business which first is exposed to

¹ The majority characterizes the services as being "at least tangentially related." Based on the evidence of third-party registrations submitted by the Examining Attorney; the fact that the identification of services in the cited registration can encompass policies and practices concerning issues specific to gay, lesbian, bisexual and transgendered employees; and the fact that the identified services can be rendered, at least in part, via an on-line global computer network, I believe that the services are more closely related than does the majority.

applicant's on-line services and finds them unacceptable might simply assume that there is a connection between applicant's services and registrant's, and not trouble to explore whether registrant is in fact connected to applicant. Second, a business which knows of registrant's services and then encounters applicant's on-line services will not, because of the nature of on-line services, have the opportunity to engage in significant discussions with the provider of applicant's services to determine whether the source of the on-line employment information services is the same as the source of the human resources consulting services. Moreover, potential customers may initially encounter registrant's services on-line, as shown by the website material for registrant which applicant has made of record. Third, to the extent that the majority is suggesting that consumers of the registrant's services would go behind registrant's trademark and thereby avoid confusion, our determination must be on the basis of whether the marks as used in connection with the respective services are likely to cause confusion.

Finally, although I have no doubt that confusion is likely, I think that the foregoing discussion at the very least raises doubt about this issue. In accordance with our long-established practice, such doubt should be

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resolved in favor of the registrant, which has owned this registration since 1987, and claims use of the mark since 1984.

Accordingly, I would affirm the refusal of registration.